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09/159,509	09/23/1998	DAN D. BROWNING	5181-11401	5208

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DAN R CHRISTEN
CONLEY ROSE & TAYON PC
P O BOX 398
AUSTIN, TX 787670398

EXAMINER

TREAT, WILLIAM M

ART UNIT	PAPER NUMBER
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2181

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/159,509
Filing Date: 9/23/1998
Appellant(s): BROWNING ET AL.

Robert C. Kowert
For Appellant

**SUPPLEMENTAL
EXAMINER'S ANSWER**

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Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on 8/1/2003 **for further consideration of a rejection**, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below:

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10-45, 46-55, 58-68, 84-94, 97-101, 102-104, and 106-108 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

A. As set forth in the following analysis, a recapture rejection of claims 10-45, 46-55, 58-68, 84-94, 97-101, 102-104, and 106-108 is appropriate in the present reissue

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application. The recapture rejection of claims 1-9, 56, 57, 69-83, and 105 is being withdrawn by the examiner.

B. In the original application for patent (application no. 07/621,474), claims 1-7 were originally presented for examination and rejected on art, Applicant then filed a File-Wrapper-Continuation (FWC) application (application no, 07/939,834, which issued as patent no. 5,559,995), in which claims 8-10 were added. Claims 1-10 were then rejected based on art. In applicant's response to the rejection (paper no. 19, filed 9/15/95):

- (1) claim 10 was canceled,
- (2) independent claims 1 and 7 were amended to include limitations to both "objects" and "at least one of wireframe objects and polygon objects," and
- (3) claim 8 was amended to include a limitation to "at least one of a wireframe and polygon based"

Amended claims 1 and 7 were repeatedly argued, in the 9/15/95 response by applicant, to distinguish over the prior art due to their inclusion of limitations to "objects" and "at least one of wireframe and polygon objects." Amended claim 8 was argued to distinguish over the prior art due to its inclusion of a limitation to "at least one of wireframe and polygon-based."

All the remaining claims 1-9 were then finally rejected on art by the examiner. In applicant's response to the final rejection (paper no. 22, filed 4/2/96):

- (1) dependent claims 11 and 12 were added,
- (2) claims 8 and 9 were canceled, and

(3) independent claims 1 and 7 were amended to include limitations to:

- a) first, second and third polygon representations of respective first, second and third virtual objects,"
- b) "selecting means, coupled to said receiving means, for selecting a first edge of said first virtual object and for selecting a second edge of said second virtual object," and
- c) "a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges, the grouped object represented by at least one of a three-dimensional and rotatable wireframe object and a three-dimensional and rotatable sweep polygon."

(Claim 7 was also amended to include other limitations, but (a) since claim 7 was more narrow than claim 1 and included all the limitations of claim 1 plus additional limitations not in claim 1, and the amendments to claim 7 were made to both the limitations included in claim 1 and the additional limitations not in claim 1, and (b) since claim 1 was allowed with its subset of claim 7 limitations, the amendments to the additional limitations found only in claim 7 and not in claim 1 need not be considered in the determination of recapture.)

These limitations were also argued, in the 4/2/96 response by applicant, to distinguish over the prior art of record, with the "three-dimensional and rotatable wireframe object and a three-dimensional and rotatable sweep polygon" limitation being repeatedly argued in applicant's response.

Claims 1-7 and 11-12 were subsequently allowed, and issued as patent no. 5,559,995 on 9/24/96. The present reissue application (application no. 09/159,509) was then filed on 9/23/98.

Given the above, for the purpose of recapture determination in the reissue application, the following limitations were added to all the independent claims that resulted in a patent, and were therefore relied upon to define over the prior art, and are considered "surrender-generating limitations", i.e., limitations (or equivalents) whose omission in their entirety would result in a reissue claim being directed to surrendered claim subject matter, and barred by the recapture rule:

Limitation A: "first, second, and third polygon representations of respective first, second and third virtual objects"

Limitation .B: "selecting means, coupled to said receiving means, for selecting a first edge of said first virtual object and for selecting a second edge of said second virtual object"

Limitation C: "a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges, the grouped object represented by at least one of a three-dimensional and rotatable wireframe object and a three-dimensional and rotatable sweep polygon"

C. The following is a breakdown of claims 10, 46, 58, 84, and 97 in the reissue application with regard to the issue of recapture, and an analysis of that breakdown:

Claim 10 does not contain any surrender-generating (relied-on) limitations or equivalents to:

"rotatable wireframe object"

"rotatable sweep polygon"

"a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges"

does contain limitations not related to the surrender-generating limitations to:

"assigning a grouping hierarchy for the first and second virtual objects, wherein the second virtual object is assigned as the child of the first virtual object"

"calculating an orientation and position of the child object relative to the first virtual object"

Claim 46 does not contain any surrender-generating (relied-on) limitations or equivalents to:

"a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges"

does contain limitations not related to the surrender-generating limitations to:

"assigning a grouping hierarchy for the first and second virtual objects, wherein the second virtual object is assigned as the child of the first virtual object"

"calculating an orientation and position of the child object relative to the first virtual object"

Claim 58 does not contain any surrender-generating (relied-on) limitations or equivalents to:

"selecting means, coupled to said receiving means, for selecting a first edge"

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of said first virtual object and for selecting a second edge of said second virtual object"

"a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges"

"three-dimensional and rotatable wireframe object"

"a three-dimensional and rotatable sweep polygon"

does contain limitations not related to the surrender-generating limitations to:

"a computer system comprising a CPU and a memory, wherein the memory stores a plurality of polygon representations of virtual objects"

"a user input device coupled to the computer system for providing user input to the computer system"

"assign a grouping hierarchy for the first and second virtual objects, wherein the second virtual object is assigned as the child of the first virtual object"

"calculate an orientation and position of the child object relative to the first virtual object"

Claim 84 does not contain any surrender-generating (relied-on) limitations or equivalents to:

"selecting means, coupled to said receiving means, for selecting a first edge of said first virtual object and for selecting a second edge of said second virtual object"

"a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges"

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does contain limitations not related to the surrender-generating limitations to:

"assign. attributes to the first and second virtual objects"

"assign a grouping hierarchy for the first and second virtual objects, wherein the second virtual object is assigned as the child of the first virtual object"

"calculate an orientation and position of the child object relative to the first virtual object"

Claim 97 does not contain any surrender-generating (relied-on) limitations or equivalents to:

"a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges"

does contain limitations not related to the surrender-generating limitations to:

"an attribute assigning means coupled to said grouping means, wherein said assigning means is configured to assign an attribute to the first and second virtual objects, wherein the attribute assigning means comprises a hierarchy means for assigning a grouping hierarchy to the first and second virtual objects, wherein the second virtual object is assigned as a child object of the first virtual object, and wherein an orientation and a position of the child object is calculated relative to the first virtual object, wherein said attribute assigning means further comprises:

an origin assigning means for assigning an origin on the first virtual object around which a third virtual object can rotate, wherein said third virtual object is selected by said selecting means from said plurality of virtual

objects; and a constraint assigning means for assigning a three-dimensional constraint of motion to the third virtual object to constrain how the third virtual object can rotate with respect to the first virtual object"

Claims 10, 46, 58, 84, and 97 do not contain at least one, or a portion of at least one, of the three above-noted surrender-generating limitations A, B, and C. Nor do these claims contain any broadened versions of, or substantially equivalent substitutes for, the omitted surrender-generating (relied-on) limitations. And while claims 10, 46, 58, 84, and 97 do contain newly added, narrowing limitations, the limitations are not in the area of the surrender. Therefore, claims 10, 46, 58, 84, and 97 are narrower than the original patent claims in an aspect not germane to what was surrendered in response to a prior art rejection, but the claims are broader than the original patent claims in an aspect germane to what was surrendered in response to a prior art rejection. Pursuant to *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening/narrowing scenario 3(a), is applied in light of *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), both of which pointed out that one should look at the limitation relied upon to define the invention over the prior art, and determine if that limitation is omitted in the reissue claims. Note also the statement

in *Clement* that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter."). (This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.)

In the present instance, similar to the facts in *Pannu*, the applicant has broadened the reissue claims 10, 46, 58, 84, and 97 in a key aspect germane to what was surrendered in response to the prior art rejection, and applicant has not narrowed those claims in the same area -- but rather in a different area. Therefore, the decision in *Pannu* is relevant to the issues on appeal because it provides an actual fact situation in which this scenario, where there was narrowing in a different area, was held to be recapture. The decision of *Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) on the other hand is not on point as to the issues at hand with respect to claims 10, 46, 58, 84, and 97. In *Eggert* the surrender-generating limitation, i.e., the limitation relied upon to define the invention over the prior art, was not omitted in its entirety, but rather was broadened. Accordingly, the Board found the claims to escape the recapture doctrine.

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In the present instance, the surrender-generating (relied-on) limitations were omitted in their entirety and therefore the claims do not escape the recapture doctrine.

D. The following is a breakdown of claim 102 in the reissue application with regard to the issue of recapture, and an analysis of that breakdown:

Claim 102 does not contain any surrender-generating (relied-on) limitation or equivalent to:

"a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges"

Claim 102 does not contain a portion of one of the three above-noted surrender-generating limitations A., B, and C. Nor does claim 102 contain any broadened version of, or substantially equivalent substitute for, the omitted portion of the surrender-generating limitation. Reissue claim 102 is, therefore, broader than the original patent claims in an aspect germane to what was surrendered in response to a prior art rejection. This broadening of the patent claims in an area of surrender is barred by the recapture rule even if there is narrowing of the claims not related to the surrender-generating limitations.

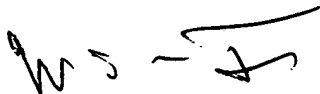
Once again, the decision of *Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is not on point as to the issues at hand with respect to claim 102. In *Eggert*, the surrender-generating limitation, *i.e.*, the limitation relied upon to define the invention over the prior art, was not omitted in its entirety, but rather was broadened. Accordingly, the Board found the claims to escape the recapture doctrine. In the

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present instance, the surrender-generating limitation was omitted in its entirety and therefore the claim does not escape the recapture doctrine.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**WILLIAM M. TREAT
PRIMARY EXAMINER**

William M. Treat

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

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Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO** **MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

A handwritten signature in black ink, appearing to read "Paul Sewell", is written over a faint, circular official stamp.

PAUL SEWELL
ACTING DIRECTOR
TC 2100